

## **REMARKS**

Claims 16-25 were pending, examined and rejected in the July 3, 2003 Office Action. No claim amendments have been made in this Response. Thus, claims 16-25 are presently pending in this application. Applicant respectfully requests reconsideration of this application.

## **CLAIM REJECTIONS - 35 U.S.C. § 103**

### **CLAIMS 16, 20, 24 and 25**

Claims 16, 20, 24 and 25 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Siemens Servo Ventilator 300 (as disclosed in the non-patent literature, Operating Manual for Siemens Servo Ventilator 300) in view of Obermayer (U.S. Patent No. 5,520,172). The Examiner acknowledges that the Siemens Servo Ventilator 300 literature does not teach a device having an inspiration valve that is closed upon expiration and having an expiration valve that is closed upon inspiration. Even if modifying the Siemens Servo Ventilator 300 device with the disclosure of Obermayer `172 did teach Applicant's claimed invention, which it would not, there is no teaching or even the faintest suggestion to combine the references. Contrary to the Examiner's argument, the disclosure in Obermayer `172 at col. 3, lines 4-8, 22-25 (FIGS. 10a, 10b) is not directed to a ventilator, but to a prior art "half-open anesthetic system," see col. 2, lines 41-45, 62-67. Although it may be important to prevent wasting anesthetic gas in the Obermayer `172 system, there is no such need expressed in the Siemens Servo Ventilator 300 disclosure, which primarily supplies air to the patient. Similarly, there is no suggestion in the Obermayer `172 patent to implement the valve configuration shown in FIGS. 10a, 10b in a ventilator such as the Siemens Servo Ventilator 300.

To support an obviousness rejection there must be some suggestion or motivation to modify a reference or combine reference teachings -- see MPEP § 706.02(j). The fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness -- see MPEP § 2143.01. In addition, merely because the claimed invention may be within the capabilities of one of ordinary skill in the art is not sufficient by itself to establish *prima facie* obviousness -- *Id.* Moreover, the prior art must suggest the desirability of the claimed invention -- *Id.* There is no such suggestion in the cited references. Without such a teaching or suggestion to combine the references, the Examiner is using improper hindsight to glean from Applicant's teachings that which is not disclosed in the prior art. See In re Fine, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Thus, Applicant respectfully submits that the Examiner's rejection of claims 16, 20, 24 and 25 under § 103 is improper and should be withdrawn.

#### **CLAIMS 17 and 18**

Dependent claims 17 and 18 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Siemens Servo Ventilator 300 in view of Obermayer `172 and further in view of Miles (U.S. Patent No. 5,353,788). As discussed above regarding independent claim 16, the Examiner's modification of the Siemens Servo Ventilator 300 device with the valve configuration of Obermayer `172 is improper and does not render Applicants' claim 16 obvious. Miles `788 does nothing to cure the deficiencies of the Examiner's rejection of claim 16. Even if modifying the Siemens Servo Ventilator 300 device with the disclosures of Obermayer `172 and Miles `788 did teach Applicant's claimed invention, which it would not, there is no teaching or even the faintest suggestion to combine the three references. Thus, Applicant respectfully submits that the Examiner's rejection of claims 17 and 18 under § 103 is improper and should be withdrawn.

### **CLAIM 19**

Dependent claim 19 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Siemens Servo Ventilator 300 in view of Obermayer `172 and further in view of Adahan (U.S. Patent No. 4,941,469). As discussed above regarding independent claim 16, the Examiner's modification of the Siemens Servo Ventilator 300 with the valve configuration of Obermayer `172 is improper and does not render Applicant's claim 16 obvious. Adahan `469 does nothing to cure the deficiencies of the Examiner's rejection of claim 16. Even if modifying the Siemens Servo Ventilator 300 device with the disclosures of Obermayer `172 and Adahan `469 did teach Applicant's claimed invention, which it would not, there is no teaching or even the faintest suggestion to combine the three references. Thus, Applicant respectfully submits that the Examiner's rejection of claim 19 under § 103 is improper and should be withdrawn.

### **CLAIMS 21 and 23**

Claims 21 and 23 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the Siemens Servo Ventilator 300 in view of Weismann et al. (U.S. Patent No. 5,647,351). The Examiner acknowledges that the Siemens Servo Ventilator 300 disclosure does not teach a pressure detector disposed on the patient connection as claimed by Applicant. Even if modifying the Siemens Servo Ventilator 300 device with the disclosure of Weismann `351 did teach Applicant's claimed invention, which it would not, there is no teaching or even the faintest suggestion to combine the references. Again, the Examiner is using hindsight gained from Applicant's teachings to pick and choose from the prior art the novel and non-obvious combination of elements in Applicant's claimed invention. Furthermore, Applicant respectfully disagrees with the Examiner's assertion that the location of the pressure detector is a mere design choice. Such a

statement is unsupported and contrary to other teachings in the art that the sensitivity and performance of a ventilator or respiratory support system is affected by the location of a pressure or flow sensor within the system. Thus, Applicant respectfully submits that the Examiner's rejection of claims 21 and 23 under § 103 is improper and should be withdrawn.

### **CLAIM 22**

Dependent claim 22 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the Siemens Servo Ventilator 300 in view of Weismann `351 and further in view of Adahan `469. As discussed above regarding independent claim 21, the Examiner's modification of the Siemens Servo Ventilator 300 with the pressure detector of Weismann `351 is improper and does not render Applicant's claim 21 obvious. Adahan `469 does nothing to cure the deficiencies of the Examiner's rejection of claim 21. Even if modifying the Siemens Servo Ventilator 300 device with the disclosures of Weismann `351 and Adahan `469 did teach Applicant's claimed invention, which it would not, there is no teaching or even the faintest suggestion to combine the three references. Thus, Applicant respectfully submits that the Examiner's rejection of claim 22 under § 103 is improper and should be withdrawn.

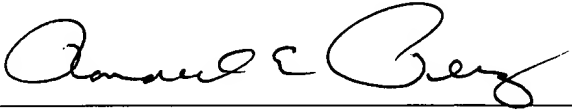
### **CONCLUSION**

In view of the foregoing, Applicant respectfully submits that claims 16-25 are in condition for allowance, and that the application should be passed to issue. The

Examiner is encouraged to contact the undersigned should there be any questions or resolvable matters regarding this application.

Respectfully submitted,

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